

DEFENDANT'S EXHIBIT D

MPEP s 2136.04
 PATENT AND TRADEMARK OFFICES
 U.S. DEPARTMENT OF COMMERCE
 MANUAL OF PATENT EXAMINING PROCEDURE
 CHAPTER 2100 PATENTABILITY
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2136.04 Different Inventive Entity; Meaning of “By Another” [R-11.2013]

[Editor Note: This MPEP section is **not applicable** to applications subject to examination under the first inventor to file (FITF) provisions of the AIA as set forth in [35 U.S.C. 100 \(note\)](#). See [MPEP § 2159 et seq.](#) to determine whether an application is subject to examination under the FITF provisions, and [MPEP § 2150 et seq.](#) for examination of applications subject to those provisions.]

I. IF THERE IS ANY DIFFERENCE IN THE INVENTIVE ENTITY, THE REFERENCE IS “BY ANOTHER”

“Another” means other than applicants, *In re Land*, 368 F.2d 866, 151 USPQ 621 (CCPA 1966), in other words, a different inventive entity. The inventive entity is different if not all inventors are the same. The fact that the application and reference have one or more inventors in common is immaterial. *Ex parte DesOrmeaux*, 25 USPQ2d 2040 (Bd. Pat. App. & Inter. 1992) (The examiner made a pre-AIA [35 U.S.C. 102\(e\)](#) rejection based on an issued U.S. patent to three inventors. The rejected application was a continuation-in-part of the issued parent with an extra inventor. The Board found that the patent was “by another” and thus could be used in a pre-AIA [35 U.S.C. 102\(e\)/103](#) rejection of the application.).

II. A DIFFERENT INVENTIVE ENTITY IS *PRIMA FACIE* EVIDENCE THAT THE REFERENCE IS “BY ANOTHER”

As stated by the House and Senate reports on the bills enacting section pre-AIA [35 U.S.C. 102\(e\)](#) as part of the 1952 Patent Act, this subsection of 102 codifies the Milburn rule of *Milburn v. Davis-Bournonville*, 270 U.S. 390 (1926). The Milburn rule authorized the use of a U.S. patent containing a disclosure of the invention as a reference against a later filed application as of the U.S. patent filing date. The existence of an earlier filed U.S. application containing the subject matter claimed in the application being examined indicates that applicant was not the first inventor. Therefore, a U.S. patent, a U.S. patent application publication or international application publication, by a different inventive entity, whether or not the application shares some inventors in common with the patent, is *prima facie* evidence that the invention was made “by another” as set forth in pre-AIA [35 U.S.C. 102\(e\)](#). *In re Mathews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969); *In re Facius*, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969); *Ex parte DesOrmeaux*, 25 USPQ2d 2040 (Bd. Pat. App. & Inter. 1992). See [MPEP § 706.02\(b\)](#) and [§ 2136.05](#) for discussion of methods of overcoming pre-AIA [35 U.S.C. 102\(e\)](#) rejections.

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